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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,004	12/08/2003	Kia Silverbrook	ZE019US	9100

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

STEPHENS, JUANITA DIONNE

ART UNIT PAPER NUMBER

2853

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/729,004	Applicant(s) KIA SILVERBROOK	
	Examiner Juanita D. Stephens	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Continuation filed 12/08/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/102,700.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/08/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/102,700, filed on 3/22/2002.

Specification

2. The disclosure is objected to because of the following informalities:

On page 1, line 1 the cross-reference to related art should be place after the Title. See MPEP 608.01(a). Also in the cross-reference to related art after "10/102,700" insert --now US Patent No. 6,692,113--, and after "March 22, 2002" insert ---.

On page 1 in the "Co-PENDING APPLICATION" section the US Patent Nos. and filing dates should be inserted, for example as shown with respect to the "cross-reference to related art", the serial numbers are as follows: 09/575,141 (6,428,133), 09/575,125 (6,526,658), and 09/575,108 (6,795,215). Application 09/575109 has not patented.

Appropriate correction is required.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **Reference numbers 18, 44, 39, 83, 59, 55, 54, 53, 52, 51, 50, 49, for example. Applicant is behooved to review the specification to make sure all the**

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reference numbers a properly identified in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 1-7 are objected to because of the following informalities:

In claim 1, line 11 replace "ink delivery assembly" with –ink distribution assembly-. In claim 1, line 14 replace "a printhead chip that is" with –the printhead chip mounted--.

The recitation of "a printhead chip" was initially recited on line 10 of claim 1.

Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/728,935. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 1 of Application No. 10/728,935 discloses a printhead assembly as recited in Claim 1 of Application No. 10/729,004, which comprises 1) an elongate support structure (claim 1, ln 2 of '935), 2) at least one elongate printhead module positioned on the support structure, along a length of the support structure (claim 1, lns 3-4 of '935), 3) an elongate elastomeric feed member that is positioned on the support structure, the feed member defining a number of longitudinally extending flow passages that are connectable to at least one ink supply, and a plurality of outlet holes in a surface of the feed member in fluid communication with the flow passages (claim 1, lns 5-7 of '935), 4) an ink distribution assembly that is positioned on the feed member, the ink distribution assembly defining a mounting formation to permit a printhead chip to be mounted on the ink delivery assembly, a plurality of ink inlets that are in fluid communication with the outlets holes of the feed member, a plurality of exit holes and tortuous ink flow paths from each ink inlet to a number of respective exit holes (claim 1, lns 8-13 of '935), and 5) a printhead chip that

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is mounted on the ink distribution assembly so that the ink can be fed from the exit holes to the printhead chip (claim 1, lns 14-17 of '935).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Foote et al. (US 6,655,786 B1)

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Foote et al. discloses a printhead assembly, which comprises 1) an elongate support structure (12) (col 3, lns 26-27), 2) at least one elongate printhead module (22)

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positioned on the support structure, along a length of the support structure (col 3, lns 31-33), 3) an elongate elastomeric feed member (second micro-molding 38) that is positioned on the support structure, the feed member defining a number of longitudinally extending flow passages (62) that are connectable to at least one ink supply, and a plurality of outlet holes (62) in a surface of the feed member in fluid communication with the flow passages, 4) an ink distribution assembly (first micro-molding 36) that is positioned on the feed member, the ink distribution assembly defining a mounting formation to permit a printhead chip to be mounted on the ink delivery assembly, a plurality of ink inlets that are in fluid communication with the outlet holes of the feed member, a plurality of exit holes and tortuous ink flow paths from each ink inlet to a number of respective exit, 5) a printhead chip that is mounted on the ink distribution assembly so that the ink can be fed from the exit holes to the printhead chip, and 6) each feed member (lower micro-molding 38) is an extruded member having a generally rectangular cross section (as seen in Fig. 6 and 12), with the ink flow paths (62) extending from one end of the feed member to an opposite end, each printhead module (22) including two closures (82 and 80) that are engageable with respective ends, of the feed member and the feed member defining a number of inlet openings (62) in the surface of the ink feed member, each inlet opening being in fluid communication with a respective flow path (58) to permit at least ink to be delivered to the flow paths.

Although Foote et al. does not specifically teach forming the holes by laser ablation, the method of forming the holes is not germane to the issue of patentability of the device itself, therefore, this limitation has not been given patentable weight.

Allowable Subject Matter

9. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 5 and 6 will be allowed when claim 4 is rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not teach, suggest, or render obvious the limitation of a delivery structure mounted on each ink feed member, each delivery structure defining a number of inlet conduits in fluid communication with respective delivery outlets, the delivery structure being engageable with the feed member such that each delivery outlet is in fluid communication with a respective ink flow path, via one of the inlet openings of the feed member. This invention solves the problem of allowing easy removal of and replacement of a defective module, which eliminates having to scrap an entire printhead if only one chip is defective.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juanita D. Stephens whose telephone number is (571) 272-2153. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Juanita D. Stephens". The signature is fluid and cursive, with the first name being the most prominent.

Juanita D. Stephens
Primary Examiner
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March 8, 2005